

**REMARKS**

Claims 1-18 are pending and are currently under examination. Claims 1-18 have been amended to better conform with U.S. patent practice. No amendments have been made due to any rejections based upon the prior art cited by the Examiner. New claims 19 and 20 have been added and are supported by the specification and the as-filed claims. The abstract has been amended as requested by the Examiner. Applicants also include, herewith, copies of references cited in Applicants' information disclosure statement as requested by the Examiner because according to the Examiner, the previous copies were not legible.

No new matter has been added.

**Abstract**

The Examiner objected to the Abstract. Applicants have amended the abstract as requested by the Examiner. Accordingly, Applicants respectfully request that the objection to the abstract be withdrawn.

**Information Disclosure Statement**

The Examiner indicated that two of the references cited in Applicants' June 13, 2005 Information Disclosure Statement have not been considered because the copies supplied by Applicants were not legible. Applicants enclose herewith a new information disclosure statement and legible copies of the references cited therein as requested by the Examiner. Applicants respectfully request that the references be considered.

**Rejection under 35 U.S.C. § 102**

Claims 1-6 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Publication 2004/0127901 (hereinafter, "Huebner-1"). Applicants respectfully disagree because the Huebner-1 reference does not teach each and every element of the pending claims.

The standard for anticipation under 35 U.S.C. § 102 is one of strict identity. An anticipation rejection requires a showing that each limitation of a claim be found in a single reference, *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). The Huebner-1 reference does not contain each limitation of the pending claims. Claim 1 states that the face of the osteosynthesis plate “intended to come into contact with the bones to be treated is flat.” According to the Examiner, the Huebner-1 reference “shows various embodiments of the device, one including a flat face that contacts the surface of the bone.” (Office Action, p. 4). The Huebner-1 reference contains nine figures, none of which show an osteosynthesis plate with a face that is intended to come into contact with the bones to be treated and that is flat. For example, in figures 3, 6A, 6B, 7, and 9 of the Huebner-1 reference where the face intended to come into contact with the bones to be treated can be seen, none of the figures teach a device where the face is flat. In Figures 3, 6A, 6B, 7, and 9 of the Huebner-1 reference the face contacting the bones is curved. Therefore, the Huebner-1 reference fails to teach an osteosynthesis plate with a face that is intended to come into contact with the bones to be treated and that is flat. Accordingly, the Huebner-1 reference fails to anticipate the pending claims.

In view of the foregoing, Applicants respectfully request that the rejection under 35 U.S.C. § 102(e) be withdrawn.

#### **Rejections under 35 U.S.C. § 103**

Claim 7 is rejected under 35 U.S.C. § 103(a) over the Huebner-1 reference in view of U.S. Publication 2004/0102778 (hereinafter, “Huebner-2”). According to the Examiner, the Huebner 1 reference fails to disclose the device comprising markings on the periphery of the device. The Examiner alleges that Huebner-2 discusses a plate comprising reference marks in order to indicate angular or linear disposition. The Examiner alleges, therefore, that the invention would have been obvious. Applicants respectfully disagree.

As discussed above, the Huebner-1 reference fails to anticipate claim 1. The Huebner-2 reference does not teach or even suggest an osteosynthesis plate containing all the elements of claim 1. The combination of Huebner-1 and Huebner-2 does not overcome the deficiency of Huebner-1 because the combination of the two references does not yield the present invention.

Further, claim 7 is not obvious because the Examiner has failed to make a proper *prima facie* case rendering claim 7 obvious. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not sufficient basis for concluding that the combination of claimed elements would have been obvious. *Ex Parte Hiyamizu*, 10 U.S.P.Q.2d 1393 (Bd. Pat. App. Int. 1988). To set forth a legally sufficient *prima facie* case of obviousness, the Examiner must show that the cited references teach or suggest a claimed invention with a reasonable expectation of success. *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988). Moreover, the prior art must provide motivation to make the proposed modifications needed to arrive at the claimed invention. *In re Lalu*, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). The Examiner has failed to provide any basis, let alone any motivation, teaching or suggestion, to modify the references to yield the claimed invention. Therefore, because the Examiner has failed to make a *prima facie* showing of obviousness claim 7 is not obvious.

Claims 8 and 13-18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huebner-1 in view of Huebner-2 further in view of U.S. Patent 6,179,839 (hereinafter “‘839 patent”). As discussed above the Huebner-1 reference fails to anticipate claim 1, from which claim 8 and 13-18 depends. The Huebner-2 and the ‘839 patent also do not anticipate the pending claims. Thus, because the primary reference does not even anticipate the independent claim from which claims 8 and 13-18 depend, the combination of the references cited does not render the claims obvious.

Further, claims 8 and 13-18 are not obvious because the Examiner has failed to make a proper *prima facie* case rendering the claims obvious. As discussed above in relation to claim 7, the Examiner describes elements in the prior art, but provides no reasoning as to why the references would be combined or that the primary reference would be modified. Without such reasoning the obviousness rejection cannot stand.

Accordingly, claims 8 and 13-18 are not obvious because Huebner-1 fails to anticipate the independent claim from which the claims depend and because the Examiner has failed to properly put forward the reasons as to why the claims are obvious.

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huebner-1 in view of Huebner-2 further in view of U.S. Patent 6,179,839 (hereinafter “‘839 patent”) further in view of U.S. Publication 2004/0039450 (hereinafter “Griner”). As discussed above the Huebner-1 reference fails to anticipate claim 1, from which claims 10 and 11 ultimately depend. The Huebner-2 and the ‘839 patent and the Griner reference also do not anticipate the pending claims. Thus, because the primary reference does not anticipate the independent claim from which claims 10 and 11 depend the combination of the references cited does not render the claims obvious.

Further, claims 10 and 11 are not obvious because the Examiner has failed to make a proper *prima facie* case rendering the claims obvious. As discussed above in relation to claims 7, 8, and 13-18 the Examiner describes elements in the prior art, but provides no reasoning as to why the references would be combined or that the primary reference would be modified to yield the present invention. Without such reasoning the obviousness rejection cannot stand.

Accordingly, claims 10 and 11 are not obvious because Huebner-1 fails to anticipate the independent claim from which the claims depend and because the Examiner has failed to properly put forward the reasons as to why the claims are obvious.

In view of the foregoing, Applicants respectfully request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

**Objections:**

Claims 9 and 12 are objected to being dependent upon a rejected base claim, but the Examiner indicated that they would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants acknowledge that claims 9 and 12 are allowable if written in independent form, and Applicants reserve the right to amend claims 9 and 12 at a later time. However, in view of the fact that the base and intervening claims are either not anticipated and/or obvious in view of the prior art cited for the reasons stated above, Applicants respectfully request that the objection be withdrawn.

**Conclusion**

Applicants believe the claims are in condition for allowance. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 963-5107 to clarify any unresolved issues raised by this response.

Respectfully submitted,

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Date: **April 4, 2007**  
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